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Amendment and/or Response  
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### REMARKS / DISCUSSION OF ISSUES

The applicants object to the Office action, and to the resultant status of this case.

The applicants filed a proper Appeal Brief on 8 March 2005. In accordance with 37 CFR 41.39, an Examiner's Answer is the proper response to an Appeal Brief. If the Examiner's Answer introduces a new ground of rejection, the appellant is given the option of requesting that prosecution be reopened, or maintaining the appeal by filing a Reply Brief that addresses the new ground of rejection. The Examiner has apparently reopened prosecution sua sponte, thereby foreclosing the applicants' right to maintain the appeal.

In the interest of advancing prosecution in this case, the following remarks are provided. If, however, these remarks fail to persuade the Examiner that all claims should be allowed, the applicants respectfully request that the next Office action be the required Examiner's Answer to the applicants' Appeal Brief, so that the applicants are provided the right to maintain their appeal, per 37 CFR 41.39.

Claims 1-15 are pending in the application.

The Examiner is respectfully requested to state whether the drawings are acceptable.

Claims are amended for non-statutory reasons: to correct one or more informalities, remove figure label numbers, and/or to replace European-style claim phraseology with American-style claim language. The claims are not narrowed in scope and no new matter is added.

The Office action rejects claim 1 under 35 U.S.C. 101. The applicants respectfully traverse this rejection. The Office action asserts that "a statutory claim would define structural and functional interrelationships between data structures or functional parts and a computer which permit the data functions to be realized". The

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Office action fails to provide a statutory basis for this assertion. The Examiner's attention is requested to MPEP 2106:

"Section 101 of title 35, United States Code, provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

... The plain and unambiguous meaning of section 101 is that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in Title 35, such as those found in sections 102, 103, and 112. The use of the expansive term "any" in section 101 represents Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101 and the other parts of Title 35. . . . Thus, *it is improper to read into section 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations.*"

Of particular note, although the applicants' invention is well suited for implementation on a computer system, the applicants' method of claim 1 does not, per se, require a computer.

Because claim 1 claims a new and useful process, the applicants respectfully maintain that the rejection of claim 1 is unfounded, per MPEP 2106.

The Office action also asserts that "claim 1 recites "a duration step" which is a non-functional descriptive material". The applicants are unable to decipher the intent or meaning of this sentence. Further, that applicants note that the phrase quoted in the Office action as being recited in claim 1, "a duration step", is not found in claim 1, or in any of the other claims.

The Office action rejects claim 1 under 35 U.S.C. 112, second paragraph. The applicants respectfully traverse this rejection.

The Office action apparently rejects claim 1 for failing to include an element of the preamble of the claim as a limitation to the claimed method. The Office action fails to provide a statutory basis for such a requirement. However, in the interest of advancing prosecution in this case, the applicants have deleted the preamble. The

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applicants respectfully maintain that claim 1 particularly points out and distinctly claims the subject matter that the applicants regard as the invention, and respectfully maintain that the deletion of the preamble has no effect on the claimed limitations or scope of the claim.

The Office action rejects claims 1-15 under 35 U.S.C. 102(e) over Phillips (USPA 2002/0107802), and under 35 U.S.C. 102(e) over Tagawa et al. (USPA 2005/0010795, hereinafter Tagawa).

The Examiner's attention is requested to MPEP 2131, wherein it is stated:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1, upon which claims 2-13 depend, claims a method that includes partitioning downloaded content into at least two sections wherein each of the at least two sections has a duration that is less than a threshold duration value assigned by a screening algorithm. Claims 14 and 15 include the same limitation.

Neither Phillips nor Tagawa teach partitioning downloaded content into at least two sections wherein each of the at least two sections has a duration that is less than a threshold duration value assigned by a screening algorithm.

The Office action asserts that each of these references teach partitioning downloaded content into at least two sections wherein each of the at least two sections has a duration that is less than a threshold duration value assigned by a screening algorithm somewhere within the first eight pages of Phillips and somewhere within the first sixteen pages of Tagawa. The applicants object to this broad-brush approach, and respectfully note that the Examiner is expected to provide a basis for each rejection with reasonable specificity.

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The Examiner's attention is requested to 37 CFR 1.104(c)(2):

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, *the particular part relied on must be designated as nearly as practicable*. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The applicants respectfully maintain that 8 pages of one reference and 16 pages of another reference cannot reasonably be considered to be a designation to a particular part as nearly as practicable, as required by 37 CFR 1.104(c)(2).

Despite the deficiencies of this Office action, the following remarks are provided regarding Philips and Tagawa.

After citing the 8 pages of Philips and 16 pages of Tagawa, the Office action asserts that "It is inherent to recognize that each AUDIO/VIDEO has a plurality of sections (sections or tracks). Also, each section or track has a time duration."

The applicants concur that each section or track of a recorded item has a time duration. However, the Office action fails to identify where either Philips or Tagawa teaches that such a time duration is less than a threshold duration value assigned by a screening algorithm, as specifically claimed in each of the applicants' independent claims. The Office action fails to identify which element in Philips or Tagawa corresponds to the applicants' claimed screening algorithm, and fails to identify which element in Philips or Tagawa corresponds to the applicants' claimed threshold duration value of such a screening algorithm.

Because the Office action fails to support the assertions that Philips and Tagawa teach partitioning downloaded content into at least two sections wherein each of the at least two sections has a duration that is less than a threshold duration value assigned by a screening algorithm, as specifically claimed in each independent claim 1, 14, and 15, the applicants respectfully maintain that the rejections of claims 1-15 under 35 U.S.C. 103(a) over either Philips or Tagawa are unfounded, per MPEP 2131.

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In view of the foregoing, the applicants respectfully request that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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